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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,371	08/22/2003	Armin Graber	302705.3003-101	8662
30407	7590	07/27/2004	EXAMINER	
BOWDITCH & DEWEY, LLP 161 WORCESTER ROAD P.O. BOX 9320 FRAMINGHAM, MA 01701-9320			WELLS, NIKITA	
			ART UNIT	PAPER NUMBER
			2881	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/646,371	Applicant(s) GRABER ET AL.	
	Examiner Nikita Wells	Art Unit 2881	<i>pm</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>72104</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Vestal et al. (5,625,184).

With respect to the claims 1, 5, 6, 10-12, 16, 22-26, and 29, Vestal et al. disclose (Col. 4, lines 16-28 and 38-50; Col. 5, lines 23-29; Col. 9, lines 11-25; Col. 9, line 66 to Col. 10, line 9; and Col. 10, lines 33-51) a method for analyzing a sample containing biomolecules comprising the steps of providing a plurality of sample portions of a sample containing biomolecules; acquiring one or more mass spectra of at least one of the sample portions; analyzing the one or more mass spectra using an expression dependent upon a mass spectrometric data based analysis, acquiring a fragmentation spectrum of at least one of the sample portions at one or more of the selected one or more mass-to-charge ratio ranges; comparing the fragmentation spectrum of at least one of the selected one or more mass-to-charge ratio ranges to a database of known or predicted fragmentation mass spectra; and determining whether a biomolecule is present in the sample based on the comparison.

With respect to the claim 2, Vestal et al. disclose (Col. 9, lines 20-25) a method for analyzing a sample containing biomolecules wherein the biomolecules comprise at least one of proteins and peptides.

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With respect to the claims 3, 13, 17, and 28, Vestal et al. disclose (Col. 4, lines 16-28; and Col. 9, line 66 to Col. 10, line 9) a method for analyzing a sample containing biomolecules wherein the step of acquiring one or more mass spectra comprises: ionizing at least a portion of the biomolecules in a sample portion using matrix assisted laser desorption ionization (MALDI).

With respect to the claims 4, 14, and 18, Vestal et al. disclose (Col. 5, lines 23-29; and Col. 14, lines 20-25) a method for analyzing a sample containing biomolecules wherein the mass spectrometer comprises a time-of-flight mass spectrometer.

With respect to the claims 7 and 19, Vestal et al. disclose (Col. 19, lines 28-40) a method for analyzing a sample containing biomolecules wherein there is comprising a step of compensating for sample bias in one or more expression level ratios.

With respect to the claims 8, 9, 20, and 21, Vestal et al. disclose (Col. 3, line 62 to Col. 4, line 3; and Col. 4, lines 38-50) a method for analyzing a sample containing biomolecules wherein the step of analyzing the one or more mass spectra comprises determining a signal intensity and a signal-to-noise ratio for the one or more mass signals.

With respect to the claims 15, 27, and 30, Vestal et al. disclose (Col. 6, lines 23-26 and 52-56; and Col. 7, lines 56-60) a method for analyzing a sample comprising a computer-readable media with computer-readable instructions.

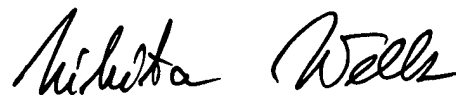
Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Parekh et al. (6,278,794 B11 and 6,064,754) and Crooke et al. (6,329,146 B1) disclose a method and apparatus for identifying, selecting, and characterizing biomolecules in a biological sample.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikita Wells whose telephone number is (571) 272-2484. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Lee can be reached on (571) 272-2477. The central fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

5. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nikita Wells

Primary Examiner, Art Unit 2881

July **23**, 2004